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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,110	07/18/2001	Russell B. Thompson	15916-249x	1696

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HENRICKS SLAVIN AND HOLMES LLP  
SUITE 200  
840 APOLLO STREET  
EL SEGUNDO, CA 90245

EXAMINER

RAM, JOCELYN DEBRA

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/909,110

Applicant(s)

THOMPSON ET AL.

Examiner

Jocelyn D Ram

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 30,31,33-44 and 46-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 43 and 46 is/are allowed.
- 6) ☒ Claim(s) 30,31,33-42,44,47-61,64,68 and 69 is/are rejected.
- 7) ☒ Claim(s) 62,63 and 65-67 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 30, 31, 34, 52-54 and 56 are rejected under 35 U.S.C. 102(b) as being anticipated by Peacock, III et al. (6,059,770). Peacock shows a catheter (10) comprising: a hollow catheter body (11) having a side wall, a tip member (19), and an aperture (20) extending through the side wall; at least one internal component (coil 15) located within the catheter body, and adhesive material (18) located within the hollow catheter body such that at least a portion of the adhesive material is in the vicinity of the side wall aperture (Fig. 1), the adhesive material securing the hollow catheter body to the at least one internal component (col 4, lines 48-50).

Claims 30-39 and 52-59 are rejected under 35 U.S.C. 102(e) as being anticipated by Webster, Jr. (5,827,278). Webster shows a catheter (10) comprising: a hollow catheter body (11) with a distal and proximal end having a tip section (12), a side wall and an aperture (col 4, lines 32-37) extending through the side wall in the proximal end (col 4, lines 41-44); at least one internal component (coil 32, puller wire 30) located within the catheter body, and adhesive material (glue joint 38) located within the hollow catheter body such that at least a portion of the adhesive material is in the vicinity of the side wall aperture (col 4, lines 32-33), the adhesive material securing the hollow catheter body to the at least one internal component, and extending around the periphery of the internal component (col 4, lines 36-39), wherein the internal component comprises a steering center support (30) and a sleeve (32) covering the steering center support (30), and further comprising at least one energy transmission element (ring electrodes 22, tip electrode 23), and a torque transfer device (18, Fig. 2).

Claims 40, 41, 45, 47, 60, 61 and 65 are rejected under 35 U.S.C. 102(e) as being anticipated by Berenstein et al. (5,895,378). Berenstein shows a catheter comprising: a hollow catheter body proximal member (202) with an inner and outer diameter, defining a distal region; a hollow catheter body distal member (204) with an inner and outer diameter, defining a proximal region, the distal and proximal members having an inner and outer diameter that is substantially the same and being respectively located such that one of the distal region of the proximal member and the proximal region of

the distal member overlaps the other, thereby creating an overlapping region (Fig. 3A); a thermal bond (206) at the overlapping region securing the proximal member (202) to the distal member (204); and at least one internal component (stylet 120) located within at least the distal member, wherein the internal component can comprise a steering center support (col 4, lines 46-52), and an adhesive (138) extends around the periphery of the internal component (Fig. 2).

Claims 40-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Fleming, III (5,718,678). Fleming shows a catheter comprising: a hollow catheter body proximal member (42) defining a distal region (56); a hollow catheter body distal member (60) defining a proximal region (64), the distal and proximal members being respectively located such that one of the distal region of the proximal member and the proximal region of the distal member overlaps the other, thereby creating an overlapping region (Fig. 5A); a thermal bond (col 8, lines 7-8) at the overlapping region securing the proximal member (42) to the distal member (60); and at least one internal component (12) located within at least the distal member, wherein the proximal member (42) includes a side wall aperture (70).

Claims 60 and 61 are rejected under 35 U.S.C. 102(e) as being anticipated by Berg (5,820,612). Berg shows a catheter comprising: a hollow catheter body including: a proximal member (12) with an inner and outer diameter, defining a distal region; a

distal member (22) with an inner and outer diameter, defining a proximal region, wherein the distal and proximal members having an inner and outer diameter that is substantially the same (Fig. 3), and one of the distal region of the proximal member and the proximal region of the distal member overlaps the other, thereby creating an overlapping region (joint 24 ); a thermal bond (col 3, lines 26-29) at the overlapping region securing the proximal member (12) to the distal member (22); and at least one internal component (braid 15) located within at least the distal member.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 44, 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berenstein (5,895,378) in view of Webster, Jr. (5,827,278). Berenstein shows all of the limitations of claim 44 except for disclosing that the internal component is a guide coil. Webster shows a similar catheter with a guide coil as an internal component. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a guide coil as taught by Webster in place of the guidewire in the device of Berenstein for guiding the catheter within the body passages.

Regarding claims 48 and 49, Berenstein shows all of the limitations except for including electrodes. Webster shows a similar catheter including a tip energy transmission element (electrode 23) and at least one internal component (lead wire 34) connected to the tip energy transmission element. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the electrodes of Webster in the device of Berenstein to allow for thermal treatment of the patient, as is well-known in the art.

Claims 64, 68 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berg in view of Webster, Jr. (5,827,278). Berg shows all of the limitations of claim 64 except for disclosing that the internal component is a guide coil. Webster shows a similar catheter with a guide coil as an internal component. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a guide coil as taught by Webster in the device of Berg for guiding the catheter within the body passages.

Regarding claims 68 and 69, Berg shows all of the limitations except for including electrodes. Webster shows a similar catheter including a tip energy transmission element (electrode 23) and at least one internal component (lead wire 34) connected to the tip energy transmission element. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the electrodes of Webster in the device of Berg to allow for thermal treatment of the patient, as is well-known in the art.

*Allowable Subject Matter*

Claims 43 and 46 are allowed. Claims 62, 63 and 65-67 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Response to Arguments*

Applicant's arguments filed 6/16/03 have been fully considered but they are not persuasive. The applicant argues that, "a steering wire and a steering center support are two complete different things". However the examiner fails to see any structural difference since the steering wire is in the center of the device and is used for steering and support, therefore it is a "steering center support". The same argument applies to the coil, stylet or tube of the other references. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within



TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jocelyn D Ram whose telephone number is (703) 308-6392. The examiner can normally be reached on Mon-Fri, 10-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

JR  
July 28, 2003

  
MICHAEL PEFFLEY  
PRIMARY EXAMINER